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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/305,586	05/05/1999	MARTIN L. HAGE	589.015US1	2339

7590 04/15/2002

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EXAMINER

JOHNSTONE, ADRIENNE C

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 04/15/2002

18

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-18

<b>Office Action Summary</b>	Applicant(s)	HAGE, MARTIN L.	
	Application No.	09/305,586	
	Examiner	Art Unit	
	Adrienne C. Johnstone	1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-9,11,12,14-16 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-9,11,12,14-16 and 21-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 5, 2002 has been entered.

### *Information Disclosure Statement*

2. In the Information Disclosure Statement filed August 21, 2000 applicant states that the references cited therein were also cited in a communication from a foreign patent office in a counterpart application, however applicant did not submit a copy of the communication (which is typically a search report indicating the degree of relevance of each reference). The examiner hereby requests a copy of this communication.

This request is repeated from Paper Number 7 paragraph 5 and Paper Number 11 paragraph 1; in the amendment after final rejection, filed January 29, 2002, applicant refers to an attached copy of the PCT search report for this application; however, such a copy is not present in the examiner's file as noted in the advisory action mailed February 7, 2002.

### *Claim Objections*

3. Claims 9 and 12 are objected to because of the following informalities: in claim 9 line 2 and claim 12 line 3 to correct a typographical error applicant should change "poly vinyl" to -- polyvinyl -- . Appropriate correction is required.

4. Claim 21 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the

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claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

As noted in the advisory action mailed February 7, 2002, claim 21 depends from now cancelled claim 2. For purposes of this examination claim 21 will be considered to depend from independent claim 1, but correction is required.

*Claim Rejections - 35 USC § 112*

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 9 and 12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

Applicant now recites in the independent claim that the film comprises a polymer having an acid value "is greater or equal to" 100; however, in claims 9 and 12 the polymer can be a cellulose-based polymer, which would not have an acid value (no pendant acidic groups or pendant salts of the acidic groups, specification p. 5 line 18 - p. 7 line 3). To overcome this rejection applicant may delete the reference to cellulose-based polymers in claims 9 and 12.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 3-5, 7-9, 11, 12, 14-16, and 21-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In the last line of claim 1 applicant should change "is greater" to -- greater than -- for proper grammar. Also, see paragraph 4 above concerning the cellulose-based polymers in claims 9 and 12 and the improper claim dependence of claim 21.

***Claim Rejections - 35 USC § 103***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 1, 3-5, 7-9, 11, 12, 14-16, and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spector et al. (5,883,169) cited by applicant in view of Fischer et al. (5,130,353), Marias Albrich et al. (6,033,718), Beavers et al. (6,106,889), and European Patent Application 0 819 744 A2.

These references are combined for the same reasons as set forth in Paper Number 11 paragraph 3, with EP '744 being added as an example of the well known technique in the aqueous coating art of requiring the acid value of a water-soluble polymer such as a water-soluble acrylic polymer to be greater than or equal to 100 in order to provide the required solubility in water (p. 8 lines 43-48). It would therefore have been obvious to one of ordinary skill in the art to employ in the above method the well known technique of requiring an acid value for the film polymer of greater than or equal to 100 in order to obtain the necessary solubility in water.

***Response to Arguments***

11. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

12. Applicant's arguments with respect to claims 1, 3-5, 7-9, 11, 12, 14-16, and 21-24 have been considered but are moot in view of the new ground(s) of rejection.

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*Conclusion*

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Matsumura et al. (6,093,240) is equivalent to European Patent Application 0 819 744 A2 already of record.

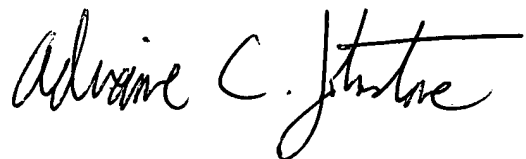
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrienne C. Johnstone whose telephone number is (703)308-2059. The examiner can normally be reached on Monday-Friday, 10:00AM-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on (703)308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9311 for regular communications and (703)872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

Adrienne C. Johnstone  
Primary Examiner  
Art Unit 1733

Adrienne Johnstone  
April 11, 2002

A handwritten signature in cursive script, reading "Adrienne C. Johnstone". The signature is written in dark ink and is positioned below the typed name and title of the examiner.